



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/911,476

07/25/2001

Hideaki Miyazaki

1405.1046

3966

21171 7590 11/27/2007
STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

BOVEJA, NAMRATA

ART UNIT

PAPER NUMBER

3622

MAIL DATE

DELIVERY MODE

11/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/911,476	Applicant(s) MIYAZAKI ET AL.	
	Examiner Namrata Boveja	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 19 and 25-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 20-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| <p>1) <input type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____;</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application</p> <p>6) <input type="checkbox"/> Other: _____</p> |
|---|--|

DETAILED ACTION

1. This office action is in response to an RCE communication filed on 09/04/2007.
2. Claim 19 has been cancelled and claims 25-27 have been withdrawn. Claims 1-18 and 20-24 are presented for examination.

Claim Rejections - 35 USC § 112

The second paragraph of 35 U.S.C. 112 is directed to requirements for the claims:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

There are two separate requirements set forth in this paragraph:

(A) the claims must set forth the subject matter that applicants regard as their invention; and

(B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

3. *Claim 1 is rejected under 35 U.S.C. 112, second paragraph, since the recitation "receive-call rejection means for comparing with the receive-call conditions points-to-be issued information issued from a calling terminal and disconnecting a call from the calling terminal," renders the claim indefinite, because it is unclear what the Applicant means by this statement. Specifically, it is unclear if the Applicant means that after doing a comparison the call is always disconnected or if the call is only disconnected when a specific condition is not met. Also, it is unclear if the receive-call condition refers to points that are issued or to something else. I.e. only points can be compared to points, since a condition can't be compared to points. It is interpreted to mean that the call is disconnected if desired by the receiver. Appropriate correction is required.*
4. *Claims 20 and 23 are rejected under 35 U.S.C. 112, second paragraph, since the recitation, "comparing with the receive-call conditions points-to-be issued information*

Art Unit: 3622

issued from the calling terminal and disconnecting the call from the calling terminal," renders the claim indefinite, because it is unclear what the Applicant means by this statement. Specifically, it is unclear if the Applicant means that after doing a comparison the call is always disconnected or if the call is only disconnected when a specific condition is not met. Also, it is unclear if the receive-call condition refers to points that are issued or to something else. I.e. only points can be compared to points, since a condition can't be compared to points. It is interpreted to mean that the call is disconnected if desired by the receiver. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 4-8, 10-12, 14, 15, and 17-24 are rejected under 102(e) as being anticipated by Walker et al. (Patent Number 6,216,111 hereinafter Walker).

In reference to claims 1, 20, and 24, Walker teaches a select-call administration method, system, and program for administrating calls pertaining to select phone calls between calling terminals and receiving terminals (abstract), the select-call administration method comprising: *accepting receive-call conditions from the receiving terminals to permit select calls on the receiving terminal end (i.e. receiver decides if he*

Art Unit: 3622

wants to take the call) (col. 3 lines 9-13, col. 8 lines 46-56); presetting point (i.e. credit) information created when a select phone call has taken place in response to a call from a calling terminal (i.e. the amount of credit the user will receive for example up to \$10 for listening to a 6-minute call is preset) (col. 3 lines 27-30, col. 8 lines 46-56); a step of notifying a receiving terminal with a notification means that a call from a calling terminal is a select phone call (i.e. when the customer answers his phone, he will hear that this call is a 6 minute recorded presentation on credit card life insurance, and if he listens to it, he will get up to \$10 as an immediate credit on his bank credit card. The customer can decide to accept this offer) (col. 8 lines 46-56); and the call is disconnected if desired by the receiver (col. 6 lines 47-51 and col. 8 lines 46-56).

6. In reference to claim 4, Walker teaches a select-call administration system characterized by carrying out a voice announcement that a call from a calling terminal is a select call (col. 8 lines 49-53).

7. In reference to claim 5, Walker teaches a select-call administration system wherein said select-call notification means incorporates into a messaging signal and transmits message information to the effect that a call from a calling terminal is a select phone call (col. 8 lines 49-56).

8. In reference to claims 6 and 7, Walker teaches a select-call administration system wherein based on the correspondence information said point-award presentation means adds and stores predetermined points (i.e. credits) to a point value set for a receiving terminal having received a call pertaining to a select phone call (col. 2 lines 63-65, col. 3

Art Unit: 3622

lines 10-14, col. 5 line 67 to col. 6 lines 6, col. 6 lines 43-46 and lines 65 to col. 7 lines 4, col. 7 lines 21-31, col. 8 lines 19-22 and 50-61, and col. 9 lines 10-13).

9. In reference to claim 8, Walker teaches a select-call administration system wherein based on point information administrated by said point information *setting* means said point-award presentation means discounts fees charged to the receiving terminals (col. 6 lines 66 to col. 7 lines 4, col. 7 lines 21-31, col. 8 lines 19-27 and 50-56, and col. 9 lines 10-13).

10. In reference to claim 10, Walker teaches a select-call administration system wherein based on the correspondence information said point-award presentation means adds predetermined points (i.e. credits) to a point value set for a third party (i.e. credits on the phone bill for answering questions about life insurance) apart from the calling terminals and the receiving terminals (col. 8 lines 19-27).

11. In reference to claim 11, Walker teaches a select-call administration system wherein said point-award presentation means based on the point information charges fees to a calling terminal having transmitted a call pertaining to a select phone call (i.e. the insurance company conducting the survey is charged with \$10 that it applied as a credit to the user's credit card or phone bill) (col. 6 lines 65 to col. 7 lines 4, col. 7 lines 21-23 and 27-29, and col. 8 lines 19-27 and 50-53).

12. In reference to claim 12, Walker teaches a select-call administration system wherein the correspondence information is call length of a select call (col. 6 lines 65 to col. 7 lines 4 and col. 7 lines 50-53).

13. In reference to claims 14 and 21, Walker teaches a select-call administration

Art Unit: 3622

system further comprising point information notification means for reporting, to the calling terminal and the receiving terminal having completed a select phone call, point information created based on the call pertaining to the select call (col. 5 lines 67 to col. 6 lines 2 and col. 6 lines 43-46).

14. In reference to claim 15, Walker teaches a select-call administration system wherein said point information notification means reports the point information via voice announcement (col. 7 lines 21-31 and col. 8 lines 49-56).

15. In reference to claims 17 and 22, Walker teaches a select-call administration system further comprising: point information setting means for presetting points (i.e. credits) added to a point value for a receiving terminal when in response to a call from a calling terminal a select phone call has taken place (col. 6 lines 66 to col. 7 lines 4, col. 7 lines 21-31, and col. 8 lines 49-56); point prior-notification means for receiving terminal, during issuance of a phone call from a calling terminal, of point information set by said point information setting means (col. 7 lines 21-31, and col. 8 lines 49-56); and receive-call selection means for a receiving terminal to select in response to a phone call from a calling terminal whether or not a select phone call takes place (col. 6 lines 16-25 and 47-51 and col. 8 lines 49-56).

16. In reference to claim 18, Walker teaches a select-call administration system wherein said point information setting means accepts points-to-be-issued information issued from the calling terminals (col. 5 lines 67 to col. 6 lines 2 and col. 6 lines 43-46).

Art Unit: 3622

17. In reference to claim 23, Walker teaches a select-call administration system wherein said receive-call selection means is provided with: receive-call condition acceptance means for accepting receive-call conditions from the receiving terminals to permit select calls on the receiving terminal end (col. 8 lines 49-56); and disconnecting a call from the calling terminal (col. 6 lines 47-51 *and col. 8 lines 46-56*).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claim 2 and 3 are rejected under U.S.C. 103(a) as being unpatentable over Walker in view of Voit et al (Patent Number 5,805,682 hereinafter Voit).

In reference to claim 2, Walker is silent about a select-call notification means that displays transmitting-terminal identification information on the receiving terminals. Voit teaches displaying transmitting-terminal identification information on the receiving terminals (abstract, col. 1 lines 20-25, col. 2 lines 17-25, and col. 6 lines 7-20). It would have been obvious to modify Walker to display transmitting-terminal identification information on the receiving terminals in order to give the recipient an option of knowing who is calling visually without having to pick up the phone instead of just orally by having to pick up the phone.

19. In reference to claim 3, Walker does not specifically disclose the transmitting-

Art Unit: 3622

terminal identification information to consist of a telephone number beginning with predetermined numerals established for said phone call. Voit teaches the transmitting-terminal identification information to consist of a telephone number beginning with predetermined numerals established for said phone call (abstract, col. 1 lines 20-25, col. 2 lines 17-25, and col. 6 lines 7-20). It would have been obvious to modify Walker to include in the transmitting-terminal identification information a telephone number beginning with predetermined numerals established for said phone call in order to let the recipient know the number of the calling party in addition to a description of the called party to enable the call recipient to call back the calling party at a later time if deemed necessary.

20. Claim 9 is rejected under U.S.C. 103(a) as being unpatentable over Walker in view of Storey (Patent Number 5,774,870 hereinafter Storey).

In reference to claim 9, Walker teaches a select-call administration system (abstract). Walker is silent about a select-call administration system wherein said point-award presentation means is provided with a merchandise information table in which point information and product information are corresponded; and where the user is prompted at the receiving terminal to select desired merchandise from the merchandise information table.

Storey teaches providing a point-award presentation means with a merchandise information table in which point information and product information are corresponded; and where the user is prompted at the receiving terminal to select desired merchandise from the information table (abstract, col. 8 lines 3-64 and col. 9 lines 6 to col. 10 lines 6).

It would have been obvious to modify Walker to include providing a point-award presentation means with a merchandise information table in which point information and product information are corresponded; and where the user is prompted at the receiving terminal to select desired merchandise from the information table to offer the recipient the option to redeem credits for other awards than just a monetary credit to his account.

21. Claims 13 and 16 are rejected under U.S.C. 103(a) as being unpatentable over Walker in view of Official Notice.

In reference to claim 13, Walker is silent about a select-call administration system wherein the correspondence information is operational information pertaining to operational content in the receiving terminals.

Official Notice is taken that it is old and well known to determine operational information pertaining to operational content in the receiving terminals such the operating system on a computer in order to ensure that the file that is being sent to the user will be accessible by the user's operating system. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include determining the operational information pertaining to the operational content in the receiving terminals in determining the correspondence information to ensure that the information being sent to the recipient for display will be visible to the recipient.

22. In reference to claim 16, Walker is silent about a select-call administration system wherein said point information notification means transmits *information* (i.e. display instructions) for displaying the point information on display devices on the calling terminals and the receiving terminals.

Official Notice is taken that it is old and well known to include display instructions for displaying point information on display devices on user terminals such as done by airline rewards websites to display mileage required for a domestic flight, an international flight, an upgrade, or free beverages. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include display instructions for displaying point information on display devices on user terminals to enable the users to visually see how much credit the user will be receiving for his participation in a given call.

Response to Arguments

23. After careful review of Applicant's remarks/arguments filed on 09/04/2007, the Applicant's arguments with respect to claims 1-24 have been fully considered but are moot in view of the new ground(s) of rejection. Amendments to the claims have both been entered and considered.

24. The previously made U.S.C. 112 rejection for claim 16 has been removed in view of the Applicant's amendments. However, two new U.S.C. 112 rejections for claims 1, 20, and 23 have been introduced as necessitated by the Applicant amendment.

25. In reference to claims 1, 20, and 24 the Applicant argues that Walker does not teach "a select-call notification means for notifying a receiving terminal that a call from a calling terminal is a select phone call." As stated in the previous Office Action, the Examiner respectfully disagrees with the Applicant, since Walker teaches this limitation in col. 8 lines 44-56 where "when the customer answers his telephone he hears: "Hello, this is a call from (name of bank); if you'll listen to a 6-minute recorded presentation on

credit card life insurance, we'll give you up to \$10 as an immediate credit on your bank credit card." As the recorded sales presentation continues, the customer may answer questions and/or accept the offer in the same manner described above." Therefore, Walker teaches giving a notification that the call is a select call by the use of a message stating the nature of the call before the user agrees to take the select call in exchange for the reward being offered to the user. Applicant further argues that in Walker the user has to first answer the phone to before the user is given the announcement. While the Examiner agrees with the Applicant that in Walker the user first answers the phone and is then presented with the notification, nothing in the Applicant's claims state that the notice regarding the call to be a select call has to be given before the user picks up the phone. If Applicant is trying to claim this feature of giving the user notice that the call is a select by displaying this information on a caller id for example prior to the user picking up the phone, he should claim this feature in the claims. Even with respect to this however, caller id devices can display if the call is from a marketer before the user answers the call.

26. With respect to claims 13 and 16, the Applicant states that he "does not admit the common knowledge or well known in the art statement," and the Applicant requests the Examiner to provide evidentiary support for the statement. With respect to this, the Examiner would like to point out that the Applicant has not presented arguments that the features are not well known. The Applicant's only argument has been, that he "does not admit the common knowledge or well known in the art statement," and that he requests the Examiner to provide evidentiary support for the statement. This does not

Art Unit: 3622

constitute a proper challenge to the Official Notice. Per the Applicant's citing of MPEP 2144.03, "A seasonable challenge constitutes a demand for evidence be made as soon as practicable during prosecution. Thus the applicant is charged with rebutting the well known statement in the next reply after the Office Action in which the well known statement was made." The Applicant has not submitted any rebuttal of the well known statements, but has merely requested references disclosing the well known limitations. In the paragraph in MPEP 2144.03 immediately preceding the above citing, reference is made to *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420-421 (CCPA 1970) that "Furthermore, the applicant must be given the opportunity to challenge the correctness of such assertions and allegations." Again, the Applicant has not challenged the correctness of the assertions but rather only the use of Official Notice itself. Bald statements such as the Applicant "does not admit the common knowledge or well known in the art statement," and the Applicant requests the Examiner to provide evidentiary support for the statement, are not adequate and do not shift the burden to the examiner to provide evidence in support of the Official Notice. Allowing such statements to challenge Official Notice would effectively destroy any incentive on part of the Examiner to use it in the process of establishing a rejection of notoriously well known facts (*In re Boon*, 169 USP 231 (CCPA 1971)). Also, with respect to claim 13, the Examiner would like to point the Applicant to Grube, Patent Number 6,026,366 where it is taught to determine operational information pertaining to operational content in the receiving terminals such the operating system on a computer in order to ensure that the file that is being sent to the user will be accessible by the user's operating

Art Unit: 3622

system and is complementary to the existing files in the receiving computer terminal.

Furthermore, with respect to claim 16, the Examiner had previously given the Applicant the example of including display instructions for displaying point information on display devices on user terminals such as done by airline rewards websites to display mileage required for a domestic flight, an international flight, an upgrade, or free beverages.

Conclusion

27. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The **Central FAX** phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).

Application/Control Number: 09/911,476

Page 14

Art Unit: 3622



NB

November 24th, 2007



RAQUEL ALVAREZ
PRIMARY EXAMINER